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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,418	04/12/2004	John E. Peters, JR.	010395-9288-01	2556
23409	7590	08/11/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			CARTER, MONICA SMITH	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,418

Applicant(s)

PETERS., JOHN E.

Examiner

Monica S. Carter

Art Unit

3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-27 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-7 and 19-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Roush (3,351,065).

Roush discloses a loose leaf binder structure comprising first and second panels (12); and a ring mechanism (base 14 having channels 16, ribs 18 and notches 20) between the first and second panels, the ring mechanism at least partially defining a spine that interconnects the first and second panels and that defines an interior spine surface and an exterior spine surface (as seen in figures 1 and 2), the ring mechanism at least partially defining a portion of the exterior spine surface (as seen in figure 1).

Regarding claim 3, the ring mechanism defines a longitudinal axis, and wherein the portion of the exterior spine surface defined by the ring mechanism is curved in a cross-section taken substantially perpendicular to the longitudinal axis (as seen in figures 3 and 4, the base is curved at the outer edges).

Regarding claim 4, the ring mechanism includes a chassis (14) configured to house a moving component of the ring mechanism, and wherein the chassis defines a portion of the exterior spine surface.

Regarding claim 5, the spine is further defined by a spine panel (10) connecting the first and second panels, and wherein the ring mechanism is connected to the spine panel (as seen in figures 1-3).

Regarding claim 6, the spine panel includes an interior surface and an exterior surface (as seen in figure 5), and wherein the ring mechanism is mounted to the exterior surface of the spine panel (as seen in figures 1-5).

Regarding claim 7, the spine panel defines an aperture (40) extending between the interior surface and the exterior surface (as seen in figures 2 and 3), and wherein the ring mechanism includes a ring (22) extending through the aperture (as seen in figures 1 and 3).

Regarding claim 19, Roush discloses a loose leaf binder structure comprising first and second panels (12); a spine panel (10) connecting the first and second panels and having an opening (40) through the spine panel; and a ring mechanism (base 14 having channels 16, ribs 18 and notches 20) mounted to the spine panel and having a ring (22) positioned through the opening (as seen in figures 1-3).

Regarding claim 20, the ring mechanism is mounted on an exterior surface of the spine panel (as seen in figures 1-3).

Regarding claim 21, the spine panel includes at least three openings (40) and the ring mechanism includes at least three rings (22), each being positioned through the openings (as seen in figures 1 and 3).

Regarding claim 22, the ring mechanism includes two hinge blades (26).

Regarding claim 23, Roush discloses a chassis (14) having a substantially continuous longitudinally-extending surface and two longitudinally-extending edges connected to the surface (the outermost edges of the base) and defining an opening (the area located between the outermost edges) (as seen in figure 2); a ring actuator (26- the hook-like projections provide the base with ring actuators in the form of hinge blades); and a ring (22) coupled to the actuator and extending through the opening away from the surface (as seen in figure 4).

Regarding claim 24, the ring actuator comprises two hinge blades as set forth in the above rejections to claim 23.

Regarding claim 25, each hinge blade engages a respective one of the edges (as seen in figure 4).

Regarding claim 26, the ring mechanism comprises at least three rings (22) (as seen in figure 1).

Regarding claim 27, the chassis defines a longitudinal axis, and wherein the surface is curved in a cross-section taken substantially perpendicular to the longitudinal axis (as seen in figures 3 and 4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10-18 are rejected under 35 U.S.C. 103(a) as being obvious over Roush.

Regarding claims 2 and 16, Roush discloses the claimed invention except for the portion of the exterior spine surface defined by the ring mechanism being metallic. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the ring mechanism being metallic instead of a flexible plastic material as set forth by Roush, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416. Furthermore, applicant has failed to disclose that the ring mechanism being metallic is critical to the invention.

Regarding claim 10, Roush discloses a loose leaf binder structure comprising first and second panels (12); a spine panel (10) connecting the first and second panels, the spine panel having an exterior surface and inherently being made of a first material having a hardness; and a shield (14) mounted on the exterior surface and made of a second material (see col. 2, lines 25-30). However, Roush fails to explicitly disclose the hardness of the shield being greater than the hardness of the spine panel. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide

any required hardness values for the shield and the spine panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 11-13, Roush discloses the shield extending the entire height in the longitudinal direction of the spine panel (see col. 2, lines 8-19).

Regarding claim 14, the binder comprises a ring mechanism (base 14 having channels 16, ribs 18 and notches 20), wherein the hardened shield comprises a ring mechanism chassis (14- base comprises shield and chassis collectively).

Regarding claim 15, the spine panel defines an aperture (40), and wherein the ring mechanism includes a ring (22) extending through the aperture (as seen in figures 1 and 3).

Regarding claim 17, the ring mechanism includes a chassis (14) that defines an exterior spine surface extending from the exterior surface of the spine panel (as seen in figures 1-3).

Regarding claim 18, the ring mechanism defines a longitudinal axis, and wherein the chassis is curved in a cross-section taken substantially perpendicular to the longitudinal axis (as seen in figures 3 and 4).

Allowable Subject Matter

5. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose binders.

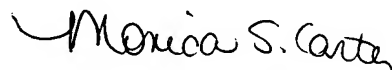
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 6, 2004


MONICA S. CARTER
PRIMARY EXAMINER